

REMARKS

By this Amendment, Applicants cancel claim 31. Thus, claims 1-6 and 9-30 are pending. No new matter is added.

Entry of the amendment is proper under 37 CFR §1.116 since the amendment merely cancels a claim (MPEP § 714.12). Furthermore, the amendment: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issue requiring further search and/or consideration since the amendment merely cancels a claim; (c) does not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) places the application in better form for appeal, should an appeal be necessary. Applicants thus respectfully request entry of the amendment.

The Office Action rejects claims 1-6, 9-26, and 31 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,394,902 to Shibao. Applicants respectfully traverse the rejection.

By this Amendment, Applicants cancel claim 31. Accordingly the rejection of claim 31 is moot. Applicants respectfully request withdrawal of the rejection of claim 31.

Shibao does not disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a compartment, the compartment being one-piece with the one of said tank portions" and "a fuel pump located entirely within the shell and fixed into the compartment," as recited in claim 1.

There are two possible interpretations of the device disclosed in Shibao that appear to relate to the subject matter of claim 1. Because it is unclear which interpretation the Office Action is relying on, Applicants treat each separately below.

According to the first interpretation of Shibao, the Office Action may be alleging that main body 4 and lid member 5 are equivalent to Applicants' claimed exterior shell formed by at least two tank portions. According to this interpretation, the pump support base 6 is

molded with main body 4 (col. 3, lines 37-44 and Figs 1 and 2), and might be interpreted as one-piece since molding may result in a single structure. However, the pump 7 is exposed outside of the lid member 5 (col. 4, lines 13-17 and Fig 1) and thus cannot reasonably be considered located entirely within the shell (4, 5). If this is the interpretation relied on by the Office Action, Shibao fails to disclose that the fuel pump is located entirely within the shell, as recited in claim 1. Accordingly claim 1 is patentable over Shibao.

According to the second interpretation of Shibao, the Office Action may be alleging that main body 4 and lid member 5 are equivalent to Applicants' claimed compartment. Thus, the claimed exterior shell would have to be the disclosed automotive fuel tank with bottom wall 2 (see col. 2, line 63 - col. 3, line 2). Initially, Applicants note that Shibao does not disclose that the automotive fuel tank with bottom wall 2 is formed by at least two tank portions, as recited in claim 1, or that it is made by molded plastics material, as recited in claim 1. In fact, it is implicit in Shibao that the automotive fuel tank is metal since metallic bracket 3 is disclosed as welded to the bottom wall 2 of the tank (col. 4, lines 3-8). Thus, if this is the interpretation relied on by the Office Action, Shibao fails to disclose that the automotive fuel tank with bottom wall 2 is formed by at least two tank portions, as recited in claim 1, or that it is made by molded plastics material, as recited in claim 1. Accordingly claim 1 is patentable over Shibao.

Furthermore, the above-described deficiencies of notwithstanding, according to the second interpretation of Shibao, the compartment (4, 5) is not one-piece with any portion of the automotive fuel tank 2. The Office Action cites a number of cases for the proposition that the term "integral" may be broadly read to include more than devices that are "one-piece" and may include constructions united by fastening and welding (see *In re Hotte*, 177 USPQ 326 (CCPA 1973); *In re Kohno*, 157 USPQ 275 (CCPA 1968); and *In re Clark*, 102 USPQ 241 (CCPA 1954) cited in the Office Action; see also, *Advanced Cardiovascular Systems, Inc. v.*

Scimed Life Systems, Inc., 887 F.2d 1070 (Fed. Cir. 1989) and *Henderson v. Grable*, 339 F.2d 465 (CCPA 1964)). However, the Office Action then incorrectly deduces the reverse, i.e., that anything "integral" may be considered "one-piece" (see Office Action page 3, lines 9-13). It is clear from the above-cited cases, including the portions relied on by the Office Action, that "one-piece" is a sub-set of the larger category "integral." Thus, the term "integral" may include devices that are truly "one-piece" and devices that are, for example, "united by fastening and welding," but not one-piece. None of the above cited cases may be relied on for the proposition that the term "one-piece" includes devices that are integral due to, for example, being "united by fastening and welding." In fact, the cases specifically recognize that "one-piece" is separate and distinct from the devices that may be considered integral by virtue of being, for example, "united by fastening and welding" (see, e.g., *Advanced*, 877 F.2d at 1072).

Because, according to the second interpretation of Shibao, the compartment (4, 5) is fastened to the automotive fuel tank 2 using external flange 4a and tank bracket 3 (col. 3, lines 3-18), the compartment (4, 5) cannot reasonably be considered one-piece with the tank 2. This is further evidenced by the fact that the compartment (4, 5) and flange 4a are made from polyacetal resin and the tank bracket 3 and tank 2 are made of metal (col. 3, lines 3-18).

In the only alternative construction discussed in Shibao, the compartment (4, 5) may be removably connected to the tank 2 using an engagement piece and engagement claw structure (col. 4, lines 48-60). However, because according to this construction the compartment (4, 5) is removably connected to the tank 2, the compartment (4, 5) cannot reasonably be considered one-piece with the tank 2.

Accordingly, if the Office Action is relying on the second interpretation of Shibao, Shibao fails to disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a

compartment, the compartment being one-piece with the one of said tank portions, " as recited in claim 1. Accordingly claim 1 is patentable over Shibao.

In view of at least the foregoing, claim 1 is patentable over Shibao. Further, Applicants respectfully submit that claims 2-6 and 9-26 are patentable at least in view of the patentability of claim 1, from which they depend, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection of claims 1-6 and 9-26.

The Office Action rejects claims 27-30 under 35 U.S.C. § 103(a) over U.S. Patent 5,394,902 to Shibao. Applicants respectfully traverse the rejection.

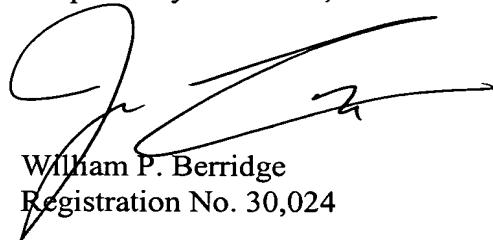
As discussed above with respect to claim 1, Shibao does not disclose "an exterior shell formed by at least two tank portions assembled together, and made of molded plastics material, one of said tank portions comprising a compartment, the compartment being one-piece with the one of said tank portions" and "a fuel pump located entirely within the shell and fixed into the compartment," as recited in claim 27. Applicants note that Shibao does not teach or suggest these features of claim 27. In fact, Shibao specifically discloses features that directly contradict the features of claim 27 (i.e., providing a lid member specifically designed to allow part of the fuel pump to be exposed outside the shell (first interpretation) or connecting the compartment (4, 5) to the tank 2 such that it is not one-piece (second interpretation)).

Because Shibao does not disclose, teach, or suggest all of the features of claim 27, claim 27 is patentable over Shibao. Applicants also respectfully submit that claims 28-30 are patentable at least in view of the patentability of claim 27, from which they depend, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection of claims 27-30.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-6 and 9-30.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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